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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,459	02/22/2002	Stanley Pohl	CP-1235 A	8399

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EXAMINER

MARKOFF, ALEXANDER

ART UNIT PAPER NUMBER

1746

DATE MAILED: 10/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/080,459

Applicant(s)

POHL, STANLEY

Examiner

Alexander Markoff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/22/02-5/9/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 3, 5. 6) ☐ Other:

**DETAILED ACTION**

***Election/Restrictions***

1. It is noted that the instant claims are directed to distinct inventions, which can properly restricted. No restriction requirement is made this time because the same prior art is applied to claims directed to these distinct inventions. However, the applicants are advised, that if the claims would be amended to put a serious burden on the examiner in further examination, such requirement can be issued.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 7-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7-10 are indefinite and incomplete because of the following:

Claim 7 requires incorporating a phosphate ester surfactant of formula I, but fails to recite to where this surfactant has to be incorporated.

The claim also fails to recite what is referenced as "the formula I". It is reasonably believed that the structure presented in the claim is what is referenced as "the formula I". However, clarification is requested.

It is further not clear how the structure presented between the preamble of the claim and the body of the claim is related to the claim. Should this structure

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be designated as Formula I and be placed in the body of the claim prior to the part specifying R, R<sup>1</sup>, and R<sup>2</sup>.

The clause "may be" in claim 7 makes the claims indefinite because renders the scope of the claims unascertainable.

Claims 11-14 are indefinite because claim 11 requires a film formed by the composition being more easily removed from the surface, but fails to recite a comparative basis.

#### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 10/080,458. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application in combination disclose all the limitations of the claims of the instant

application. It is noted that the specific copolymers disclosed by the claims of the copending application are species of the genus of the acrylate copolymers recited by the claims of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dias et al (US Patent No 6,432,147, WO 98/27945).

The relevant parts are cited using the US Patent.

Dias et al teach a hair coloring composition comprising the claimed ingredients:

hydrogen peroxide in the claimed range (see at least column 5, line 64 – column 6, line 12; column 6, lines 45-53);

acrylate copolymer in the claimed range (see at least column 25, lines 50-67);

claimed phosphate ester surfactant (see at least column 27, lines 41-53);

claimed cosolvents (see at least column 26, lines 1-24); and

water (see at least column 26, lines 1-5).

Dias et al teach the claimed pH. See at least Abstract, columns 5 and 10, claims 1-2.

Dias et al does not specifically teach a range for the concentration of the claimed surfactant. However, in all the examples surfactants are presented in the range 1.5-1.7%. This concentration is in the claimed range.

It would have been obvious to an ordinary artisan at the time the invention was made to provide any of the disclosed surfactants in this range with reasonable expectation of adequate results because this range is recommended by the reference.

9. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the state of the prior art admitted by the applicants in the specification (pages 1-2) in view of Dias et al (US Patent No 6,432,147, WO 98/27945).

The applicants admitted in the specification that thickened hair dye compositions comprising acrylate copolymers leave a polymeric film on the stainless steel equipment.

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The applicants also admitted that this film is conventionally removed by a hot alkaline solution.

Dias et al teaches a hair coloring composition, which is thickened by acrylate copolymers.

It would have been obvious to an ordinary artisan at the time the invention was made that such composition would leave the polymer film disclosed by the admitted prior art.

It would have been obvious to an ordinary artisan at the time the invention was made to remove this film by a conventional prior art method, i.e. by cleaning with an alkaline solution with reasonable expectation of adequate results.

The composition of Dias et al comprises the claimed ingredients and has the claimed pH.

Thus the prior art cleaning method applied to the equipment used with the composition of Dias et al would meet the claimed limitations.

As to claims 9 and 10:

The admitted prior art does not disclose the pH of the used alkaline solution and fails to disclose a cleaning pressure.

However, the pH (concentration) of the cleaning solution and the pressure of the applied cleaning solution are result effective variables.

It would have been obvious to an ordinary artisan at the time the invention was made to find an optimum pH and an optimum application pressure by routine experimentation.

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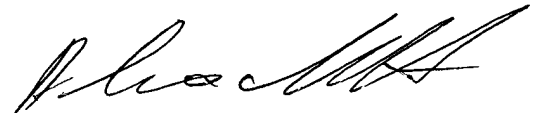
**Conclusion**

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patents No 6,022,381, 6,309,426 and 6,398,821 are cited to show the state of the prior art with respect to hair coloring compositions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Markoff whose telephone number is 703-308-7545. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P Gulakowski can be reached on 703-308-4333.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703--308-0651.



Alexander Markoff  
Primary Examiner  
Art Unit 1746

am

ALEXANDER MARKOFF  
PRIMARY EXAMINER